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10/762,440	01/22/2004	Bernard J. Kerr	260-006	5178

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EXAMINER
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PARK, JEONG S

ART UNIT	PAPER NUMBER
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2154

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12/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

mw

<b>Office Action Summary</b>	Application No. 10/762,440	Applicant(s) KERR ET AL.	
	Examiner Jeong S. Park	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/12/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 6-8, 14-16 and 22-24 are objected to because of the following informalities:

In claim 6, line 3, the phrase "detail information" should be corrected as --said detail information-- for clear understanding of the claim. Similar correction should be made for claims 7, 8, 14-16 and 22-24.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said graphic indication" in line 1. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 17-24 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17 is drawn towards a computer program product comprising a computer readable medium having computer program. The computer readable medium defined in the specification is not in one of the statutory categories. The specification provides no explicit and deliberate definition of the computer readable medium.

Claims 18-24, which are dependent on claim 17, do not provide any explicit and deliberate definition of the computer readable medium to the claim and thus are rejected for the same.

Claim 26 is drawn towards a computer data signal embodied in a carrier wave. The computer data signal embodied in a carrier wave is not in one of the statutory categories.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Aravamudan et al. (hereinafter Aravamudan)(U.S. Patent No. 6,301,609 B1).

Regarding claims 1, 9, 17, 25 and 26, Aravamudan teaches as follows:

a method of providing a local computer system user (subscribing client, 140 in figure 1 and 2) with detail information (pending events, see, e.g., col. 7, lines 3-33) about at least one remote computer system user (selected buddies, 140 in figure 1 and 2)(IM sever sends an instance message communicating the pending event from the

selected buddies, see, e.g., col. 7, lines 21-40), comprising:

obtaining, by an awareness client application process (downloaded client software 204 in figure 4) executing on a local computer system from an associated awareness server application process executing on a server computer system (the user installs the provisioning software such as IM client application onto his CPE device from the IM server, see, e.g., col. 6, lines 32-63), an online status of said remote computer system user (IM sever sends an instance message communicating the pending event such as status of selected buddies, see, e.g., col. 7, lines 21-40);

presenting, by said awareness client application process, an awareness object (events) associated with said remote computer system user, wherein said awareness object includes an indication of said remote computer system user (all clients being used as subscribing client or buddy should be registered first by indicating user's online status and current user address, see, e.g., col. 7, lines 1-8 and step 234 in figure 5, information relating to the buddy's premises equipment such as Internet address, see, e.g., col. 9, lines 52-52) wherein said awareness object further includes a visual indication of said online status of said remote computer system user (IM sever sends an instance message communicating the pending event such as status of selected buddies, see, e.g., col. 7, lines 21-40);

obtaining, by said awareness client application process on said local computer system, responsive to said presenting said awareness object (events) associated with said remote computer system user (selected buddies), detail information regarding said remote user, wherein said detail information is obtained from a detail information

database server (Communication Services Platform (CSP) server 160 in figure 1 and 2) process separate from said awareness server (IM server 130 in figure 1 and 2) application process (the events stored at the CSP is sent to the subscribing client by an instance message through IM server, see, e.g., col. 7, lines 21-40);

detecting a selection of said awareness object associated with said remote computer user by said local computer system user (the events to monitor for the selected buddies are personalized by the user (subscribing client) and stored at the CSP rules database 168 in figure 1 and 2, see, e.g., col. 8, lines 37-55)(the subscribing client is notified with the events, see, e.g., col. 7, lines 21-40); and

presenting, by said awareness client application process, said detail information regarding said remote computer system user in a display for said local computer system (IM sever sends an instance message communicating the pending event, see, e.g., col. 7, lines 21-40, displaying is inherent in the instance messaging).

Regarding claims 2, 10 and 18, Aravamudan teaches as follows:

conveying, in association with a user identifier (see, e.g., col. 9, lines 52-52) for said remote computer system user, an identifier of said detail information database server process (the selected events inherently are assigned for necessary identification in order to process in data communications) from said awareness application server process to said awareness application client process (IM server sends the selected events to the subscribing client based on the identifier of each selected event and the buddy, see, e.g., col. 7, lines 21-40);

determining, by said awareness application client process in response to said

selecting of said awareness object associated with said remote computer system user, said identifier of said detail information database server process (it is inherent to determine a identifier of any data to process properly); and

wherein said obtaining said detail information regarding said remote computer system user is performed by said awareness application client process (IM client software) over a communications network using said identifier of said detail information database server process (it is inherent to obtain the events regarding buddy's identity and the identity of the events).

Regarding claims 3, 11 and 19, Aravamudan teaches as follows:

said obtaining said detail information regarding said remote computer system user is performed through an application programming interface (IM application between the IM server and the IM client) to said detail information database server process (utilizing the existing and emerging instant messaging services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action, see, e.g., col. 2, lines 25-32).

Regarding claims 4, 12 and 20, Aravamudan teaches as follows:

said presenting said graphic indication (a computer with display unit is inherently provide the graphic indication on IM client computer) of said remote computer system user comprises presenting said graphic indication of said remote user in a display window for an application process executing in said local computer system separately from said awareness client application process (IM client software)(when the subscribing is off-line, the CSP determines an alternative disposition for the initiating

important event such as automated calls to the registered mobile phone or email to the other registered device, other than sending an instance message, see, e.g., col. 8, lines 56-65 and col. 11, lines 21-34).

Regarding claims 5, 13 and 21, Aravamudan teaches as follows:

said presenting said detail information regarding said remote computer system user presents said detail information through a pop-up display window (showing pop-up window is inherent function and is well-known in the art, see, e.g., col. 11, lines 21-24).

Regarding claims 6, 14 and 22, Aravamudan teaches as follows:

presenting an interface to said local user, wherein said interface enables said local user to indicate whether detail information regarding said local user is to be shared with other users (assigning a buddy priority to individual buddies or groups of buddies in order to maintain control of his privacy with respect to his online location, presence, and activities, see, e.g., col. 9, line 63 to col. 10, line 15).

Regarding claims 7, 15 and 23, Aravamudan teaches as follows:

presenting an interface to said local user, wherein said interface enables said local user to specify detail information regarding said local user that is to be shared with other users (different priority, such as high, low and highest priority, to individual buddies determines different level of presence information such as real-time presence, shielding the user's activity and so on, see, e.g., col. 9, line 45 to col. 10, line 51).

Regarding claims 8, 16 and 24, Aravamudan teaches as follows:

presenting an interface to said local user, wherein said interface enables said local user to specify one or more other users with which detail information regarding



said local user is to be shared (the subscribing client creates buddy groups and defines specific attributes to associates included with each group, see, e.g., col. 9, lines 45-52).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 5-8, 9, 13-16, 17, 21-24, 25 and 26 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-9, 10, 15-18, 19, 24-27, 28 and 29 respectively of copending Application No. 10/762,423. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Because it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the document access activity information as taught by the copending application with the detail information.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeong S. Park whose telephone number is 571-270-1597. The examiner can normally be reached on Monday through Friday 7:00 - 3:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JP

December 7, 2007

NATHAN FLYNN  
SUPERVISORY PATENT EXAMINER

